

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

**In re the Reissue Application of:**

**BILL L. DAVIS and JESSE S. WILLIAMSON**

For Reissue of U. S. Patent 5,630,363

Issued May 20, 1997

Serial No. 08/515,097

Filing Date: May 20, 1999

Serial No.: 09/315,796

For: **COMBINED LITHOGRAPHIC/  
FLEXOGRAPHIC PRINTING  
APPARATUS AND PROCESS**

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§  
§  
§ Group Art Unit: 2854

Examiner: S. Funk  
J. Hilten

**SUBMISSION OF FINAL JUDGMENT ON  
CONSENT ENTERED IN CONCURRENT LITIGATION**

To: The Honorable Commissioner of  
Patents and Trademarks  
Washington, D.C. 20231

Sir:

Enclosed is a copy of the Final Judgment On Consent entered in the Northern District of Texas on January 23, 2001. The parties agreed, and the Court so ordered, adjudged and decreed, that on June 12, 1994 Davis and Williamson made certain disclosures concerning the Davis and Williamson invention to PRI's Baker, that Baker told PRI product manager and Serial No. 08/435,798 Co-applicant Bird of the information received from Davis and Williamson, and further that pursuant to a subsequent request on July 7, 1994, PRI's Rendleman prepared drawings of a ferris wheel device for the invention of Davis and Williamson.

Litigation Plaintiffs/PTO Protestors have conceded the alleged inventorship and state claims issues in the litigation, Davis and Williamson's priority to the '363 claimed subject matter, and the claimed subject matter of this reissue proceeding, and the validity and enforceability of the '363 claims.

Litigation Plaintiffs and Protestors have also admitted they know of no additional material prior art and other information that beyond what reissue applicants have already submitted to the PTO. See Counsel's letter of January 23, 2001 to the undersigned attached.

Respectfully submitted,



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Reg. No. 27,877

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**ATTORNEY FOR REISSUE APPLICANTS**

09315796-052401  
F04250-9675FE60

06/25/2006

**BILL L. DAVIS and JESSE S. WILLIAMSON**

Serial No. 08/515,097

Group Art Unit: 2854

Examiner: S. Funk  
J. Hilten

For: **COMBINED LITHOGRAPHIC/  
FLEXOGRAPHIC PRINTING  
APPARATUS AND PROCESS**

I hereby certify that the following documents were served on Plaintiffs' counsel by delivering a true and correct copy thereof to the offices of Plaintiffs' counsel by depositing in first class mail on the 24th day of January, 2001, addressed as follows:

William D. Harris, Jr.  
LOCKE LIDDELL & SAPP, LLP  
2200 Ross Ave., Suite 2200  
Dallas, Texas 75201

1. **Submission of Final Judgment on Consent Entered in Concurrent Litigation**


  
Robert Hardy Falk

TABLE 1		TABLE 2		TABLE 3		TABLE 4		TABLE 5		TABLE 6		TABLE 7		TABLE 8		TABLE 9		TABLE 10		TABLE 11		TABLE 12		TABLE 13		TABLE 14		TABLE 15		TABLE 16		TABLE 17		TABLE 18		TABLE 19		TABLE 20		TABLE 21		TABLE 22		TABLE 23		TABLE 24		TABLE 25		TABLE 26		TABLE 27		TABLE 28		TABLE 29		TABLE 30		TABLE 31		TABLE 32		TABLE 33		TABLE 34		TABLE 35		TABLE 36		TABLE 37		TABLE 38		TABLE 39		TABLE 40		TABLE 41		TABLE 42		TABLE 43		TABLE 44		TABLE 45		TABLE 46		TABLE 47		TABLE 48		TABLE 49		TABLE 50		TABLE 51		TABLE 52		TABLE 53		TABLE 54		TABLE 55		TABLE 56		TABLE 57		TABLE 58		TABLE 59		TABLE 60		TABLE 61		TABLE 62		TABLE 63		TABLE 64		TABLE 65		TABLE 66		TABLE 67		TABLE 68		TABLE 69		TABLE 70		TABLE 71		TABLE 72		TABLE 73		TABLE 74		TABLE 75		TABLE 76		TABLE 77		TABLE 78		TABLE 79		TABLE 80		TABLE 81		TABLE 82		TABLE 83		TABLE 84		TABLE 85		TABLE 86		TABLE 87		TABLE 88		TABLE 89		TABLE 90		TABLE 91		TABLE 92		TABLE 93		TABLE 94		TABLE 95		TABLE 96		TABLE 97		TABLE 98		TABLE 99		TABLE 100	
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U.S. DISTRICT COURT  
NORTHERN DISTRICT OF TEXAS  
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CLERK, U.S. DISTRICT COURT  
By [Signature]  
Deputy

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ENTERED ON DOCKET

JAN 23 2001

U.S. DISTRICT CLERK'S OFFICE

On this date, came the parties in this action and announced, prior to trial and after having taken substantial discovery on the issues and claims in this action, that they had reached a settlement agreeing to entry of this Final Judgment on Consent, and the Court being of the opinion that this judgment should be entered as agreed to by the parties, it is hereby

**ORDERED, ADJUDGED and DECREED as follows:**

1. Plaintiff Printing Research, Inc. ("PRI") is a corporation of the State of Texas, having its principal place of business in Dallas, Texas.
2. Plaintiff Howard W. DeMoore ("DeMoore") is an individual who resides in Dallas, Texas.
3. Plaintiff Ronald M. Rendleman ("Rendleman") is an individual who resides in this judicial district.
4. Defendant Williamson Printing Corporation ("WPC") is a corporation of the State of Texas, having its principal place of business in Dallas, Texas.
5. Defendant Bill L. Davis ("Davis") is an individual who resides in Irving, Texas.

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6. Defendant Jesse S. Williamson ("Williamson") is an individual who resides in Dallas, Texas.

7. For the purpose of this action, this Court has personal jurisdiction of PRI, DeMoore, Rendleman, WPC, Davis and Williamson.

8. This Court has subject matter jurisdiction pursuant to 28 U.S.C. §§ 1338 and 1367.

9. WPC is the owner of United States Patent No. 5,630,363 ("the '363 patent"). On May 20, 1999, WPC filed application serial number 09/315,796 in the United States Patent and Trademark Office ("PTO") to reissue the '363 patent ("the Reissue Application"), which is presently pending in the PTO.

10. The uncontroverted evidence in the record shows that, in June of 1992, Davis and Williamson conceived the invention described and claimed in the '363 patent.

11. The evidence in the record further shows that, on June 12, 1994, Davis and Williamson disclosed the invention of the '363 patent to Steve Baker ("Baker"), a salesman of PRI, telling him that they wanted to apply inks or coatings using the flexographic process upstream of or prior to printing with lithography in a continuous in-line process on an offset lithographic press and that they wanted to use a retractable, interstation printer/coater having an anilox roller and chambered doctor to perform the flexographic process, and that on June 15, 1994, Baker told John W. Bird ("Bird"), product manager of PRI, the information that Davis and Williamson had disclosed to Baker on June 12, 1994.

12. WPC entered into an agreement with PRI to provide to WPC a retractable, interstation flexographic printer/coater with an anilox roller and a chambered doctor.

13. Pursuant to DeMoore's request on July 7, 1994, Rendleman, who was employed by PRI, prepared drawings of the ferris wheel, retractable flexographic printer/coater shown in Figure 2 of the '363 patent. The ferris wheel, retractable flexographic printer/coaters

manufactured and delivered to WPC by PRI were paid for by WPC pursuant to the agreement between WPC and PRI.

14. On May 4, 1995, DeMoore, Rendleman and Bird filed U. S. patent application serial number 08/435,798 ("the '798 application"). The overlapping process disclosure common to the '798 application and the '363 patent and the Reissue Application originated from Davis and Williamson. The subject matter of unprosecuted method claims 24-35 of the '798 application, and narrower claims thereof, do not conflict with the '363 patent and the Reissue Application. Davis, Williamson and WPC do not claim inventorship of the claimed subject matter of claims 1-23 of the '798 application pending (allowed or on appeal) as of December 1, 2000, and the unprosecuted claims 24-35 of the '798 application, and any claims of U.S. Patents No. 5,598,777, No. 5,631,316, No. 5,960,713, and No. 6,116,158.

15. Plaintiffs no longer contend that they, individually, collectively or in any combination, is or are a sole or joint inventor of any claim of the '363 patent as issued or any of claims 1-87 of the Reissue Application pending as of December 1, 2000.

16. With respect to all claims of the '363 patent as issued and claims 1-87 of the Reissue Application pending as of December 1, 2000, priority rests in the inventive entity of Davis and Williamson and not in any entity consisting of one or more of DeMoore, Rendleman and Bird.

17. There was no fraud or inequitable conduct in the prosecution of the application that resulted in issuance of the '363 patent.

18. Based on the evidence in the record in this action, the information presently known to the parties, and the prior art and other information of record in the Reissue Application, all claims of the '363 patent as issued, and claims 1-87 of the Reissue Application, are valid, including being valid under the provisions of 35 U.S.C. §§ 102 (a), (b), (c), (e), (f) and (g) and 103.

19. Apart from the specific findings set forth herein, all claims and counterclaims of the parties in this action are hereby dismissed with prejudice.

20. The parties waive all right to appeal from this judgment.

21. Each party shall pay its own attorney's fees and costs.

22. This Court shall retain jurisdiction to enforce this judgment and the settlement agreement entered into by the parties with respect to this action.

SO ORDERED on this 22 day of January, 2001


  
BARBARA M.G. LYNN  
UNITED STATES DISTRICT JUDGE

APPROVED AND AGREED TO  
AS TO FORM AND CONTENT:

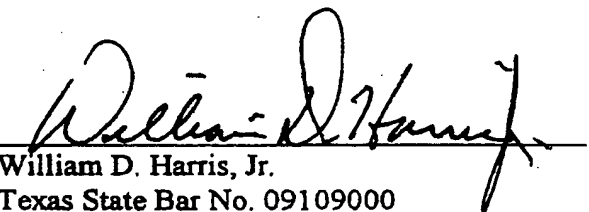
PRINTING RESEARCH, INC.

By: 

Dan L. Boyles  
Its: President

 1/16/01  
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By: Jesse S. Williamson, Jr. President

Jesse S. Williamson

Its: President

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January 25, 2001

## VIA FEDERAL EXPRESS

Examiner Stephen Funk  
United States Patent and Trademark  
Office Group 2854  
Room 9D35 - Crystal Plaza IV  
Arlington, VA 22202

Re: Reissue Application Serial No. 09/315,796 to Davis and Williamson  
Our File: WILL 2501


Dear Mr. Funk:

Enclosed are the original of two papers for filing:

- 1) SUBMISSION OF FINAL JUDGMENT ON CONSENT ENTERED  
IN CONCURRENT LITIGATION; and
- 2) SUBMISSION OF EXPERT REPORTS IN CONCURRENT  
LITIGATION.

I am working hard on the other papers so that they can be transmitted to you directly this week.

Respectfully submitted,

  
Robert Hardy Falk

RHF:lc  
Enclosures

cc: John P. Pinkerton, Esq.

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### SUBMISSION OF EXPERT REPORTS IN CONCURRENT LITIGATION

Enclosed are the expert reports submitted by reissue applicants and their corporate assignees (defendants) in the Northern District of Texas in *Printing Research, Inc., Howard W. DeMoore and M. Rendleman v. Williamson Printing Corporation, Bill L. Davis and Jesse S. Williamson*, Case No. 3-99CV1154M, together with the reports for their adversaries, Plaintiffs PRI, Moore and Rendleman:

- (1) Professor W.S. Mott, Technical Expert  
2359 Leona Avenue  
San Luis Obispo, California 93401-5368  
Report Dated: October 4, 2000 (**Yellow-Orange Tab 1**)
- (2) Warren B. Kice, Patent Expert  
Haynes & Boone, L.L.P.  
901 Main Street, Suite 3100  
Dallas, Texas 75202-3789  
(No substantial formal report submitted)  
Informal Report Dated: October 5, 2000 (**Orange Tab 2**)

- (3) Edward G. Fiorito, Patent Expert  
6925 Spanky Branch Drive  
Dallas, Texas 75248-1527  
Undated Report Submitted: November 17, 2000 (Strawberry Tab 3)
- (4) Lar Manke, [Alleged] German Patent Expert  
Amalienstrasse 40  
80199 Munich  
Federal Republic  
Report Submitted: November 17, 2000 (Red Tab 4)

For Defendants Williamson Printing Corporation, Bill L. Davis and Jesse S. Williamson:

- (1) Bernarr R. Pravel, Esq., Patent Expert  
Akin, Gump, Strauss, Hauer & Feld, LLP  
711 Louisiana Street, South Tower, Suite 1900  
Houston, Texas 77002  
First Report Dated: October 5, 2000 (Light Purple Tab 5)
- (2) Raymond J. Prince, Technical Expert  
Senior Technical Consultant, Technical Services Group  
Graphic Arts Technical Foundation (GATF)  
200 Deer Run Road  
Sewickley, Pa. 15143-2600  
Report Dated: November 15, 2000 (Purple Tab 6)
- (3) James E. Taylor, Technical Expert  
4129 Drowsey Lane  
Dallas, Texas 75233  
Report Dated: November 15, 2000 (Blue Tab 7)
- (4) Bernarr R. Pravel, Esq., Patent Expert  
Akin, Gump, Strauss, Hauer & Feld, LLP  
711 Louisiana Street, South Tower, Suite 1900  
Houston, Texas 77002  
Second Report Dated: November 16, 2000 (Aquamarine Tab 8)

### THE EXPERTS' POSITIONS

#### I. Plaintiffs' Position

Plaintiffs' experts' reports were received from Mott (Yellow Orange Tab 1), Fiorito (Strawberry Tab 3), and Manke (Red Tab 4). No formal report was received from Kice (Orange Tab 2).

Professor Mott, in a 4½ page report, opined that the May 4, 1995 PRI application [Serial No. 08/435,798] was enabling (Report at pp. 3,4):

"In my opinion, the disclosure in the May 4, 1995 Patent Application by Printing Research Inc., would enable an experienced, educated person in the commercial printing industry to understand the nature of the device, how it is mounted on an offset lithographic press and the manner in which the device is utilized for printing. It would certainly teach the process of printing in-line in a single pass of flexography followed by one or more lithographic steps.

"I am of the opinion that the language and teaching in Patent Application filed May 4, 1995 is quite sufficient to teach one of ordinary skill in the art how to practice the invention ultimately described in the '363 patent. This is based on a review of the May 4, 1995 application and the '363 patent. Moreover, I also believe that the May 4, 1995 application likewise teaches how to practice the concepts developed by DeMoore and Rendleman that are described above in the preceding paragraph."

Mott also alluded to purported summer 1994 discussions between DeMoore and Ronald Rendleman, but referred to no original PRI document, deposition testimony or witness statements to back up his assertion of a PRI-based conception prior to May 4, 1995:

"I was asked to consider when and what constituted a sufficient mental formulation by the inventor(s) of a complete idea for a product or process in the present matter. I was to consider that the idea must be of specific means, not just a desirable end or result, that must be sufficiently complete so as to enable anyone of ordinary skill in the art to reduce the concept to practice. In the context of on-line upstream single pass flexographic printing followed by lithographic printing, the ferris wheel coater (Rendleman coater) mounted upstream in combination with a multi-station press accomplishes this. The summer of 1994 discussions between Howard DeMoore and Ronald Rendleman, followed by the sketches of the winter of 1994, and particularly of December 30, 1994 by Rendleman meet the foregoing requirements.

"In a broader sense, the summer disclosure of Mr. DeMoore and Mr. Rendleman by which his thinking or concept was disclosed by his inquiry to Mr. Rendleman of whether he could place a coater interstage discloses the recognition by Mr. DeMoore of the desirability of having a convertible (from lithographic) flexographic step or station upstream of lithographic stations. This convertible concept contrasts with a dedicated flexographic station to provide the upstream flexographic step. When the ferris wheel type coater is used the concept involves the use of a convertible flexo/litho station. *I have not yet formulated an opinion as to whether the disclosure involving only generally flexo before litho (single pass) constitutes a sufficiently complete idea to teach one how to practice or perform but I expect to supplement this report if I do. I do believe that this is a broad idea that may be short of a concrete concept.* The addition of a convertible printing station with a Rendleman coater provides a specific means to accomplish the desired result." (Emphasis supplied.)

Mott, therefore, does not conclude that DeMoore-Rendleman had a conception in the summer of 1994, but only much later in 1994, in the "winter of 1994", when Rendleman had mechanical drawings.

Kice submitted, in reissue applicants' opinion, no formal report (**Orange Tab 2**).

Plaintiffs' patent expert Fiorito (**Strawberry Tab 3**) took issue with expert Pravel's initial position (**Light Purple Tab 5**) that Plaintiffs had derived the invention from Defendants or were equitably estopped (Fiorito Report pp. 8-9), took the position that certain of the '363 claims were

supported by Serial no. 08/435,798 (Fiorito Report pp. 8-9 and **Exhibit C** hereto), took the position that Rendleman was a co-inventor of at least '363 Claim 15 because of the means clause contained therein and '363 Fig. 2 (Fiorito report pp. 9-14), and that because of German MAN-Roland Gebrauchsmuster 93 05 552U and German abstracts (Patent blatt 113.Jhrg. Heft 28 (July 15, 1993) and WILA-GMA-Heft 28 (July 15, 1993) disclosing Fig. 1 and Claim 1 of 93 05 552U), the Gebrauchsmuster was "published" and that, in his opinion, in order to construe the '363 claims as being valid thereover, one had to include the cantilevered device limitations of the device made of Rendleman as part of the means claims:

"In my opinion, in order to construe the claims of the '363 patent for inventorship purposes it is necessary to review the disclosure in the German patent application in a manner that would attempt to preserve the validity [of] some or all of the claims of the '363 patent."

Note Fiorito report, p. 16.<sup>1</sup>

Fiorito concluded that the Gebrauchsmuster is "high pertinent prior art" against '363 (Fiorito, p. 15). Fiorito cited no case law for his position.

Lars Manke, a four year German patent agent, testified by way of an report as to the nature of German Gebrauchsmusters and that with respect to MAN-Roland Gebrauchsmuster G 93 05 552.8U, it was registered April 16, 1993 and that the registration "has been published in the official PATENT GAZETTE and in the unofficial UTILITY MODEL BULLETIN on July 15, 1993. Manke testified that from June 3, 1993 "any third party had the opportunity to get knowledge of the content of the above utility model" and that from July 15, 1993 the German application, while not "printed", could be inspected by any third party and was available on microfiche.

Reissue applicants have previously taken a position that Manke, not a lawyer, is not competent to be an expert.

## **II. Defendants' Expert Positions**

In his report (**Purple Tab 5**), Defendants' legal expert Pravel - formerly of the national patent firm Pravel, Hewitt, Kimball & Krieger - testified that based on the depositions of ex-PRI employees Baker, Bird, Garner and reissue applicants Davis and Williamson, and the PTO declarations and supplemental declarations of Baker and Bird that PRI, DeMoore and Rendleman derived the process invention from Davis and Williamson on June 12, 1994 at a restaurant meeting in Atlanta and that the earliest contention of DeMoore as to a possible conception - July 7, 1994 - being several weeks later, came as a result of Jesse Williamson's and Bill Davis' disclosure of the

<sup>1</sup> Defendants maintain that the July 7, 1993 patent abstract reports do not disclose reissue applicants' invention and that Fiorito's position is completely unsupported in the case law. Each of the claims have an inventorship based on their language and are either valid or invalid.

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invention to Baker several weeks earlier. Defendants' contention is supported by the supplemental declarations of Baker and Bird, of record.

Pravel in his first report also concluded that in view of the testimony of Baker and Bird that Jesse Williamson and Bill Davis disclosed at the offices of WPC in conference room "E" in January 1995 that WPC was going to file an application on the Davis-Williamson process and PRI was equitably estopped to challenge the '363 inventorship in Davis and Williamson view of a four-year delay citing Hottel Corp. v. Seamon Corp., 833 F.2d 1570, 1573, 4 USPQ2d 1939, 1941 (Fed. Cir. 1987) and MCV, Inc. v. King-Seely Thermos Co., 870 F.2d 1568, 1571 (Fed. Cir. 1989):

"The '363 patentees communicated to PRI employees Bird and Baker in January 1995 that they would file an application on what they considered to be their new, improved process. Bird testified that he considered the process to be that of the '363 patentees and made no objection.

"The PRI team - Bird, Rendleman and DeMoore - filed their patent application on May 4, 1995 but did not claim the '363 process. In fact, at no time to date did they amend their claims in Serial No. 08/435,798, even within the one year period permitted by law after the issuance of the '363 patent on May 20, 1997, to copy any of the issued '363 claims. Significantly, former PRI Vice-President Garner testified that they knew about the '363 patent in last 1997 or early 1998.

"Despite Garner's testimony, DeMoore and PRI indicated in their COMPLAINT that they did not know about the '363 patent until December, 1998 and learned about it only through a potential customer. *This connection lacks any credibility whatsoever, given DeMoore's intense interest in patents, his interest in a device to practice the '363 process, his financial interest in the equipment to practice the process, and his financial losses alleged in his Complaint. I have had many small to medium-sized clients who were manufacturing mechanical devices, and periodic review of the patent literature for competitive patents is commonplace. DeMoore's allegation of learning about the issuance of the '363 patent in December, 1998 is unbelievable.*

"Regardless, PRI's delay in [pursuing] and claim to the '363 invention or filing suit - of over four years - was unreasonable. MCV, *supra*. The first element of the Hottel test has been met.

"Defendant WPC's only hope of realizing significant income from the '363 process - other than selling printed materials made according to the process - is licensing the '363 process to others. As long as an inventorship fight hangs as a cloud over the '363 patent, licensing possibilities are remote, if not impossible. The second element of Hottel has clearly been not.

"PRI, having been told of the forthcoming filing of the application for the '363 process in January, 1995 and having done nothing in 1995, 1996, 1997 or 1998 to copy the '363 claims, while at the same time continuing to do business with Defendants during that time period, including, but not limited to, the construction and delivery of interstation coaters and driers in 1995-1997, induced Defendants

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into reasonably believing PRI would not assert any claims of the '363 process. The third element of Hottel has been met.

"Defendants acted to their detriment in relying on Plaintiffs' acquiescence concerning their failure to claim the '363 process. Defendants could have gone to any one of a number of different "rack-back" manufacturers to develop an alternative "rack-back" in 1995-1998, which manufacturers were identified in the Garner and Bird depositions. Instead, the declaration and deposition testimony shows that Printing Research installed at least three interstation machines in the period 1995-1997, that Williamson paid for the machines manufactured for them at their request to perform the '363 process, and proceeded to try to work out their difficulties with Printing Research. The fourth and final element of Hottel has therefore been met. The letters attached to the Rule 57(b) declaration of '363 patentees indicated that PRI did not object to the identity of the '363 patentees as solely consisting of Williamson Printing Corporation employees Davis and Williamson until March, 1999 during license negotiations. After prosecuting Serial No. 08/435,798 for four years without claiming the '363 process, and after being told before they filed their application by Davis and Williamson that the latter would file an application on that process, plaintiffs are estopped to pursue claims of inventorship of the '363 process. MCV." (Emphasis supplied)

In a lengthy technical report, former Dahlgren Chief Engineer, James E. Taylor (**Dark Purple Tab 6**) testified as to his lengthy history in the development of auxiliary retractable coaters (pp. 1-7), testified at length as to the prior art to the '363 with respect to anilox roll inking/coating systems, roll metering methods (pp. 8-13) and seven known prior art types of auxiliary retracting systems (pp. 14-20). Taylor concluded that based on the facts disclosed in the two declarations of Baker and the information transmitted from Jesse Williamson and Bill Davis to Baker on June 12, 1994, together with the testimony of Bird in two declarations, that one of ordinary skill "could have readily constructed a retractable printer/coater with an anilox roller and chambered doctor for interstation use in the summer or fall of 1994 without undue experimentation, and that the information given to Baker was sufficient to instruct the average person skilled in the art what to do to arrive at a device to perform the flexographic lithographic process." Taylor Report, p. 22, ¶47. Taylor concluded that neither the December 1994 drawings, taken alone, or the May 4, 1995 PRI application was enabling. *Id.* Taylor also concludes that pending Claims 1, 12 and 13 of Serial No. 08/435,798 are obvious in view of Bird U.S. Patent No. 4,481,903, in view of Sarda, U.S. Patent No. 4,889,051. Taylor also concluded that none of the claims of U.S. Patent No. 5,960,713 to DeMoore, et al. are supported/taught by U.S. Serial No. 08/435,798.

Taylor provides a formidable detailed analysis of the auxiliary retractable coater art, the patents of which are located behind his report.

Technical Expert, Ray Prince (**Blue Tab 7**) reached similar and parallel conclusions as expert Taylor.

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Based upon the technical observations of Taylor and Prince, legal expert Pravel in his second and final report (Aquamarine Tab 8) concluded that Davis and Williamson had a conception as of June 1992 which was collaborated and complete and recognizable under U.S. law as of Bowyer's trip to the United States in October, 1992 (Pravel 11/16/2000 Report p.3, ¶4), and that such conception was further corroborated by former PRI employee Baker, testifying about the June 12, 1994 restaurant meeting in Atlanta (note Baker's Second Supplemental Declaration). Pravel concludes that Davis and Williamson had every right under the Agawam case to use the services of PRI without losing their right to a patent:

"According to the Rule 131 declaration mentioned in paragraph 4, and the testimony of each of Davis and Williamson in their respective depositions, Davis and Williamson had a discussion with Baker of PRI on **June 12, 1994**, in which they asked Baker of PRI to consider constructing a retractable device for WPC to perform the Davis/Williamson method. An inventor "may use the services, and aid of others in the process of perfecting this invention without losing his right to a patent." *Shatterproof Glass Corporation v. Libby-Owens Ford Company*, 758 F.2d 613, 624, 225 USPQ 634 (Fed. Cir. 1985) citing *Hobbs v. U.S. Atomic Energy Commission*, 451 F.2d 849, 864, 171 USPQ 713 (5<sup>th</sup> Cir. 1971); see also, *Hess v. Advance Cardiovascular Systems, Inc.*, 106 F.3d 976, 980-981, 41 USPQ2d 1792, 1786 (Fed. Cir. 1997). Furthermore, Fig. 2 of the '363 patent, according to the expert report of Jim Taylor, was within the method concept of Davis and Williamson. See paragraph 47, Expert Report of Taylor. Williamson and Davis hired PRI to make an auxiliary, retractable interstation coater with an anilox roller and chambered doctor. Under the applicable law, Davis and Williamson had the right to have a vendor or contractor at arms length perform the construction of a device for use with their inventive method to reduce the invention to practice. Based on one of the landmark patent cases of the United States Supreme Court, an inventor may hire another to construct a device to perform his invention, and such hiring does not operate to create a joint invention because the intellectual property rights of the contractor belong to the true inventor. See *Agawam Company v. Jordan*, 74 U.S. (7 Wall.) 583, 19 L. Ed. 177(1868). Under the *Agawam* case, the cantilevered device technology, whether or not patentable, becomes the property of Davis and Williamson. According to expert Taylor, there were at least seven known techniques in 1994 of accomplishing the concept of the Davis and Williamson method. Nuances in the construction of an apparatus to perform the Davis/Williamson process do not change inventorship of the method or ownership rights with respect to the apparatus:

"... such suggested improvements are in general to be regarded as the property of the party who discovered the original principle, and may be embodied in his patent as part of his invention."

"*Agawam*, 19 L. Ed at 182. See also, *Amax Fly Ash Corporation v. United States*, 206 Ct. Cl. 756, 514 F.2d 1041, 1050, 182 USPQ 210, 185 USPQ 437 (Ct. Cl. 1975); *Mueller Brass Co. v. Reade Industries*, 352 F.Supp. 1357, 1374, 176 USPQ 361 (E.D.P.A.



1972); *Rodgard Corporation v. Miner*, 914 F.Supp. 907, 917-918 (W.D.N.Y. 1995)."

Pravel 11/16/2000 Report, ¶6. Pravel also concluded that DeMoore's contention as to a PRI alleged conception of the '363 invention in DeMoore or Rendleman lacked corroboration (Pravel 11/16/2000 Report, ¶9, citing *Burroughs Welcome Co. v. Barr Lab Inc.*, 40 F.3d 1223, 1228, 32 USPQ2d 1915 (Fed. Cir. 1994); *Price v. Symse*, 988 F.2d 1187, 1194-1196 (Fed. Cir. 1993); and *AMP, Inc. v. Fujitsu Microelectronics, Inc.*, 853 F. Supp. 808, 821-822 (N.D. Pa. 1994)) and that the '363 *method* is not revealed in the Rendleman November 1994-February 1995 drawings. *Id.*, ¶10. Pravel also concludes that as Serial No. 08/435,798 did not satisfy the "how to use" requirements of 35 USC § 112, 1<sup>st</sup> paragraph, that it was non-enabling as well, citing *In re Gardner*, 427 F.2d 786, 789, 166 USPQ 138 (CCPA 1970) *Id.*, ¶¶110-11. Pravel indicates that joint inventorship of the '363 patent is impossible, as the parties (PRI and WPC) never collaborated and there was no testimony of same. *Id.*, ¶12.

Pravel also concluded that none of the claims of the four "double bump" PRI applications leading to U.S. Patents No. 5,598,777; No. 5,651,316; No. 5,960,713; and No. 6,116,158 have support in Serial No. 08/435,798 (Pravel 11/16/2000 Report ¶¶ 18-20).

#### **REISSUE APPLICANTS' ANALYSIS OF THE EXPERT REPORTS**

The uncontradicted testimony shows that Davis and Williamson conceived of their invention in early June, 1992 and that said invention was corroborated first in October, 1992 (Note old 35 U.S.C. §104) upon the visit to the United States by Harry Bowyer and further corroborated by their transmission of the conception to PRI's salesman Baker on June 12, 1994 at an Atlanta restaurant. WPC experts Pravel and Taylor opine the disclosure was enabling. The PRI expert is silent on this point. According to both Baker and his superior Bird, that conception was given to DeMoore sometime in the next several days following June 12, 1994, probably June 15, 1995. DeMoore vigorously disputes this testimony and indicates that he arrived at the conception independently on July 7, 1994 and told his employee Rendleman. Bird and Baker testify in their supplemental declarations, and Bird testified in his September deposition that DeMoore was told about the Davis-Williamson process on June 15, 1994 at PRI's offices in Dallas, Texas.

WPC experts Taylor and Prince both testify that neither the November 1994 - February 1995 Rendleman drawings of PRI or the PRI patent application Serial No. 08/435,798 were enabling. The WPC experts point to alleged "how-to-use" and motivational deficiencies in the fall-winter drawings for the claimed method, and the failure of the patent application to incorporate by

reference (or teach the equivalent of) the "WIMS" patent, U.S. Patent No. 5,370,976 to Williamson, et al.

WPC experts Taylor and Prince both testify that a variety of auxiliary retraction devices existed as of both June 1992 and June 1994 which could be modified to practice the Davis-Williamson methodology. There were seven different types in all. Expert Taylor laboriously went through each of the seven prior art methods and investigated the known prior art to each, including the cantilevered or "ferris wheel" type. Taylor concluded that PRI could be fairly described as a novice as of fall 1994 in auxiliary retractable coater design (pp. 24-26, ¶47), which explained excessive time and money to make their cantilevered devices for WPC. Prince indicates (p. 13, ¶8(s)) that PRI's reputation ranks below Dahlgren and Epic in the auxiliary coater market, and that very few of DeMoore's patents pertain to commercial devices. *Id.*

Based upon the technical analysis of Prince, Pravel concludes that neither the '713 patent or its three sisters (the '777, the '316 and the '158) could ever properly claim the benefit of the filing date of Serial No. 08/435,798 – May 4, 1995. Pravel 11/16/2000 Report, ¶¶18-19 at pp 17-20. Pravel also concluded that the '713 was inequitably procured, as the '713 patentees did not timely disclose the '363 Davis-Williamson patent and withheld foreign published counterparts of Serial No. 08/435,798, including EP 741,025 (A2) and EP 741,025 (A3).

Late in the litigation, as the cumulation of fact witness depositions and expert witness testimony showed that PRI it had a losing position.

At the inception of the litigation, DeMoore contested he was the sole inventor of the '363 claims. In his Amended Complaint, DeMoore said he and Rendleman were co-inventors of all the claims. After the depositions, PRI started backtracking again on its inventorship positions and maintained that Rendleman was only a co-inventor of Claims 15-16 with Davis and Williamson, maintaining that the ferris wheel device of Fig. 2 was the only "means" disclosed in the '363 to perform the invention and had to equate to the "flexographic ink-providing means".

The assertion that Claims 15 and 16 are limited to a retractable ferris wheel coater under 35 U.S.C. §112, paragraph 6, is incorrect. The "flexographic ink-providing means" element of Claim 15 is a means-plus-function element in which the function is "applying a flexographic ink to said blanket cylinder to form an image." Since the structure described in the specification to perform this function is an anilox roller (see, e.g. col. 7, lines 1-4, 41-44 and 49-52), the "flexographic ink-providing means" element of Claim 15, as properly construed, covers an anilox roller and equivalents thereof. Under the applicable case law, it would be improper to include the ferris wheel retraction mechanism as a part of the "flexographic ink-providing means" because §112, paragraph 6, does not "permit incorporation of structure from the written description beyond that necessary

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to perform the claimed function." Micro Chemical, Inc. v. Great Plains Chemical Co., 194 F.3d 1250, 1258 (Fed. Cir. 1999). (. . . "Section 112, par. 6 requires both identification of the claimed function and identification of the structure in the written description necessary to perform that function"). See also, Rodime, PLC v. Seagate Technology, Inc., 174 F.3d 1294, 1302 (Fed. Cir. April 13, 1999) and Serrano v. Telular Corporation, 111 F.3d 1578, 1580 - 1583 (Fed. Cir. 1997). Claim 16, which is dependent on Claim 15, supports this construction of the "flexographic ink-providing means" because it specifies that the "flexographic ink-providing means" includes "a flexographic ink supply and an anilox roller associated with said flexographic ink supply for transferring said flexographic ink to said flexographic plate." *Means clauses are not restricted to preferred embodiments in the law.* Maytag Corporation v. Whirlpool Corporation, 95 F. Supp.2d 888, 895 (N.D. Ill. April 27, 2000) ("A means-plus-function claim encompasses all structure in the specification corresponding to that element all equivalent structures").

Furthermore, this construction of Claims 15 and 16 is consistent with the doctrine of claim differentiation because independent Claim 15 is broader than Claim 16, equivalents thereof. Laitram Corp. v. Rexnord, Inc., 939 F.2d 1533, 1538 (Fed. Cir. 1991). Claim 16 of the '363 recites expressly the anilox roller limitation, so that Claim 15, and by the doctrine of claim differentiation, must mean at least a structure as broad as anilox roller and equivalents. Clearstream Wastewater Systems, Inc. v. Hydro-Action, 206 F.3d 1440, 1446-1447 (Fed. Cir. March 27, 2000).

Thus, there is no basis to assert that Rendleman is a co-inventor of Claims 15 or 16 because, among other reasons, these claims by operation of law are not limited to a retractable ferris wheel coater.

Respectfully submitted,



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§  
§ Group Art Unit: 2854

§ Examiner: S. Funk  
§ J. Hilten

For: **COMBINED LITHOGRAPHIC/  
FLEXOGRAPHIC PRINTING  
APPARATUS AND PROCESS**

I hereby certify that the following documents were served on Plaintiffs' counsel by delivering a true and correct copy thereof to the offices of Plaintiffs' counsel by depositing in first class mail on the 24th day of January, 2001, addressed as follows:

William D. Harris, Jr.  
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- ## 1. Submission of Expert Reports in Concurrent Litigation

Robert Hardy Falk

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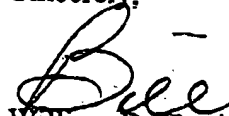
Dallas, Texas 75201

Re: Printing Research, Inc., et al. v. Williamson Printing Corporation, et al.; Civil  
Action No. 3:99-CV-1154-M

Dear Bobby:

This is to confirm that we have no documents at all that set up the Dennis Griggs patent application serial number 08/435,798, file B5602 and none giving input from PRI or its employees before May 4, 1995.

Sincerely,

  
William D. Harris, Jr.

WDH:ecr